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PATENT & TRADEMARK OFFICE

IPW

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yukio SAKASHITA

Group Art Unit: 2813

Application No.: 10/542,956

Examiner: T. NGUYEN

Filed: April 24, 2006

Docket No.: 124796

For: THIN FILM CAPACITANCE ELEMENT COMPOSITION, HIGH PERMITTIVITY INSULATION FILM, THIN FILM CAPACITANCE ELEMENT, THIN FILM MULTILAYER CAPACITOR AND PRODUCTION METHOD OF THIN FILM CAPACITANCE ELEMENT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the September 3, 2008 Restriction Requirement, Applicant provisionally elects Group I, claims 1-14, with traverse.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. *See* MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

> Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims, as stated in ISPE 10.06:

> Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

> If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

See also MPEP §1850(II).

The restriction requirement properly acknowledges that there is common subject matter between independent claims 1, 3, 4, and 5 because it categorizes all these claims into Group I. The Restriction Requirement states that claims 15-24 are drawn to a distinct invention from the invention claimed in claims 1-14; however, this assertion is not in keeping with the above-explained PCT standard. Claims 15-24 variously depend from claim 1 and, thus, require all of limitations of claim 1. As stated above, unity of invention is not considered between independent and dependent claims. The subject matter of claim 1 is common to claims 2 and 6-24.

Accordingly, all the claims share common subject matter and, therefore, *a priori* unity of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.07 and 10.08. However, the Office Action fails to even assert

that the common subject matter is found in the prior art. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus a restriction requirement based on a lack of unity of invention is improper.

Reconsideration and withdrawal of the restriction requirement are respectfully requested.

Respectfully submitted,

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